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No. 1439

Supreme Court, U.S.
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In the

Supreme Court of the United States

OCTOBER TERM, 1970

ETHICON, INC.,

Petitioner,

vs.

HANDGARDS, INC., ET AL.,

Respondents.

REPLY TO THE BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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Handgards opposes the petition for certiorari on the fallacious premise that the Ninth Circuit Court of Appeals applied this Court's strict standard of proof not only in *Tucker Aluminum Products, Inc.* v. *Grossman,* 312 F.2d 293 (9 Cir. 1963), but in the case here before the Court.

The cases show, on the contrary, that the Ninth Circuit departed radically from the rule of *The Barbed Wire Patent* and cut itself off from the other Circuits when it drove a wedge between "clear and satisfactory" and "beyond a reasonable doubt" in *Tucker.* The decisions following *Tucker* in the Ninth Circuit conclusively demonstrate the substantive effect of change (Pet. p. 10).

We need only add in this reply that Handgards' view of the Court of Appeals decision here is as mistaken as its view of *Tucker*. Handgards contends that the Court of Appeals implicitly adopted the trial court's statement that the proofs were beyond a reasonable doubt when it said the findings were not "clearly erroneous." But that cannot be accurate because the "clearly erroneous" criterion of Rule 52(a) applies only to fact findings; the issue of whether the evidence met the correct evidentiary standard is an issue of law which must be reviewed by the appellate court (*Baumgartner* v. *United States,* 322 U.S. 665, 671 (1944)).

Properly read, the Court of Appeals decision simply required that the defendant's proofs present a case which "could have been decided either way." Having found that the proofs met that requirement, the Court of Appeals accepted the trial court's findings as not clearly erroneous. In so doing, the Court abdicated its responsibility to review the findings in relation to the heavy burden of proof and thereby adopted an approach which is fundamentally inconsistent with *The Barbed Wire Patent* rule. (Compare *Jones Knitting Corporation* v. *Morgan,* 361 F.2d 451 (3 Cir. 1966), where the Court said (at page 455), "this court is under a duty to scrutinize it [the evidence] very carefully." See also, *Soccodato* v. *Dulles,* 226 F.2d 243 (D.C. Cir. 1955).)

The fundamental conflict in this important area of patent law is precisely the kind of unhealthy nonuniformity which generates multiple patent suits. This Court is now considering the question of whether relitigation in the patent field should be curtailed by abandoning the

rule of *Triplett* v. *Lowell,* 297 U.S. 638 (1936),* but a departure from the *Triplett* rule is even more reason for uniformity in the law of patent defenses. The Court has laid down uniform rules for determining patentability under 35 U.S.C. § 103 in *Graham* v. *John Deere Co.,* 383 U.S. 1 (1966). The public use defense under 35 U.S.C. § 102 requires the same thorough review here.

Respectfully submitted,

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* *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation and JFD Electronics Corporation,* Petition No. 338. The rule of *Triplett* simply stated is that *res judicata* considerations cannot apply where the parties in the two suits are different.